

REMARKS

Claims 1-25, 27 and 28 remain pending in this application. Claim 26 had been cancelled. Claims 6-28 have been withdrawn from consideration by the examiner as being directed to a non-elected invention. The Examiner has treated the election as being without traverse.

Claims 1-5 have been rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure which is allegedly not enabling. Although the examiner considers a reaction of a compound of formula 1 to form a compound of formula 2 to be essential to the practice of the invention, the examiner has taken the position that the claims do not require this feature. This rejection is traversed as the preamble explicitly recites that the claim is directed to a “method of producing an acyl group-containing composition” and the body of the claim explicitly recites both a “step of reacting” two compounds and that “the acyl group-containing composition comprises at least one acyl compound represented by the following general formula (2).”

While the examiner’s observation is correct that the claimed method does involve a reaction of a compound of formula 1 to form a compound of formula 2, it is respectfully submitted that claim 1 as originally drafted recites just such a reaction. Nevertheless, in an attempt to provide even greater clarity, claim 1 has been amended to duplicate the limitation already present in claim 1 in the preamble by pointing out that the method is directed to producing a composition containing at least one acyl compound presented by the general formula (2). Accordingly, this rejection should be withdrawn.

Claims 1-5 also have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because claim 1 allegedly does not recite a product and some confusion about the phrase “which is defined as reaction step.” As discussed above,

claim 1 did and does recite that the product of the claimed reaction is a composition comprising at least one acyl compound represented by the general formula (2). In addition, claim 1 recites that the method “comprises a step of reacting a long chain N-acyl acidic amino acid anhydride represented by . . . formula (1) . . . with one or more compounds having . . .” the recited characteristics. As such, the phrase “which is defined as reaction step” is superfluous and has been deleted.

As noted in claim 1, the “m functional groups” to which the examiner referred in the Office action, are present on the one or more compounds that are reacted with the anhydride of formula (1) to produce a composition comprising at least one acyl compound of general formula (2) wherein the functional groups are substituted on X and bind to Z. Accordingly, these rejections should be withdrawn.

Claim 1 has been rejected under 35 U.S.C. § 102 as being anticipated by JP 502973 (JP 973). According to the examiner, JP 973 teaches the preparation of menthol esters of N-acyl long chain amino acid anhydrides that anticipates claim 1. Claim 1, however, explicitly requires that the reaction of the anhydride of formula (1) with one or more compounds with the recited functional groups occurs “in an aqueous solvent and/or a mixed solvent of water and an organic solvent.” Neither the examiner nor the English-language abstract of JP 973 addresses this explicit limitation of claim 1.

To anticipate a claim, the reference must teach every element of the claim. MPEP 2131. The invention of claim 1 relates to a method of producing a compound having at least two acyl acidic amino acid residues in the molecule (note that n is an integer of 2 to 20 in formula (2)), whereas JP 973 discloses a compound obtained by conducting the reaction of the anhydride with a compound having one hydroxyl group in

a ratio of one molecule of the acyl acidic amino acid anhydride to one molecule of the compound having one hydroxyl group to obtain a reaction product that has only one acyl amino acid residue in the molecule. In addition, as disclosed on page 2, lines 13-21 of the present specification, the reaction described in JP 973 takes place in an organic solvent such as toluol or benzol and does not have at least an aqueous component as recited in claim 1. Accordingly, for each of these reasons, claim 1 is not anticipated by JP 973. This rejection should be withdrawn.

Finally, claims 2-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 973. According to the examiner, the additional limitations of these claims cover molar ratios and purification steps that are within the purview of those of ordinary skill in order to obtain an isolated product. Applicants traverse this rejection for at least the reasons discussed above regarding significant differences between the teachings of JP 973 and the recitations of claims 1-5. The prior art fails to provide any reason to change the basic teachings of JP 973 in such a way that would yield a method according to the claimed invention. Since the prior art fails to establish a prima facie case of unpatentability, this rejection should be withdrawn.

Prompt and favorable reconsideration is requested.

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Respectfully submitted,

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